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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,242	04/24/2001	Soren Vindriis	CU-2508RJS	3307

26530 7590 10/23/2002

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EXAMINER

ARNOLD III, TROY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

LC

Office Action Summary

Application No.

09/830,242

Applicant(s)

VINDRIIS, SOREN

Examiner

Troy Arnold

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In lines 9-10, the phrase "where the fabric is joined with the foil by enclosure in the foil" is unclear and misleading, as the fabric does not appear to be actually enclosed or surrounded by the foil layer. Claim 3 is simply not understood.

A term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "foil" in claim 1 is used by the claim to mean "layer," while the generally accepted meaning is "a thin sheet of metal or metallic material."

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by

Hutcheson. Regarding claim 1, Hutcheson teaches an insole 10 comprising a top plastic layer 12 and a bottom plastic layer 14 and cavities 26+ formed between the two layers, with a liquid 42 inside, the layers being impermeable and joined along the edges, and a fabric 56,58 extending along the layers, extending outside the layers, and wherein the fabric is joined to the layers. See column 5, beginning in line 18. (The last four lines of claim 1 are given little patentable weight, as they describe a *process for making* the instant invention, rather than the structure of the invention itself.) Regarding claim 2, one or more of the materials 56,58 specified for the outer covering of the invention of Hutcheson will have a coefficient of friction higher than that of the bottom plastic layer. Regarding claim 3, Hutcheson teaches the top plastic layer covered with fabric such as cotton or synthetic material. Inasmuch as the claim is understood, it would appear that a variety of coefficients of friction will be covered by the material specified by Hutcheson in column 5, lines 23-28, thus satisfying the limitations of the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hutcheson. Hutcheson teaches all the limitations of claim 4 except the fabric having a higher tensile strength than the top plastic layer. In view of the various materials suggested by Hutcheson in column 5, lines 43-48, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tensile strength of the fabric material higher than that of the plastic layer for the purpose of ensuring that the fabric adequately protected the plastic layer against rupture. This is clearly well within the capability of one of ordinary skill in the art.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hutcheson in view of Filipitsch et al. Hutcheson teaches all the limitations of claim 5 except the top fabric layer being impregnated with fungicide. Filipitsch teaches an insole impregnated with a fungicide, as in claim 13. It would have been obvious in view of Filipitsch to one of ordinary skill in the art at the time the invention was made to incorporate fungicide into the top material layer of Hutcheson for the purpose of improving the sanitary environment of the foot. See also Hutcheson, column 5, lines 33-37 where he discusses additive substances.

It is noted that several other of the references cited but not relied upon teach most of the limitations claimed in the claims, in similar structures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Arnold whose telephone number is 703-305-0621. The examiner can normally be reached on Tuesday-Thursday, 9:30-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-0302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Troy Arnold
Examiner
Art Unit 3728

TGA
October 17, 2002



Mickey Yu
Supervisory Patent Examiner
Group 8700